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In re application of

Larson et al.

Serial No. 10/625,860

Filed: July 23, 2003

For: SYSTEM FOR CONTAINING AND PROCESSING SMALL OBJECTS

DECISION ON  
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION filed May 4, 2007.

On July 11, 2006, a non-final office action was mailed to applicant rejecting claims 1, 3-7, 10, 12, 15, and 16 under 35 USC 102(b) over the Feygin (US 6,315,957) reference. A reply to the office action was filed by applicants on January 10, 2007. In the reply, applicants amended previously presented claims 1 and 12 by narrowing the scope of the small objects and the liquid. A final office action was mailed by the office on April 17, 2007, containing a new grounds of rejection of claims 1, 3-7, 10-16 and 18 over the Feygin reference under 35 USC 102(e). On May 4, 2007, the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the April 17, 2007 office action.

Petitioner's position for the withdrawal of the finality is that the finality is improper since the section of 35 USC 102, under which the Feygin reference was applied, was changed from (b) to (e) in the final office action, and since claims 11, 13-14, and 18 were not previously rejected under 102 and thus the applicant had not had a chance to respond to such rejections previously.

**DECISION**

Section 706.07 of the MPEP states:

**706.07(a) Final Rejection, When Proper on Second Action**

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In the non-final rejection of July 11, 2006, claims 1, 3-7, 10, 12, 15, and 16 were rejected under 35 USC 102(b) over the Feygin (US 6,315,957) reference. A reply to the office action was filed

by applicants on January 10, 2007. In the reply, applicants amended previously presented claims 1 and 12 by narrowing the scope of the small objects and the liquid. The applicant further argued that the Feygin reference did not qualify as prior art under 35 USC 102(b). A final office action was mailed by the office on April 17, 2007, containing a new grounds of rejection of claims 1, 3-7, 10-16 and 18 over the Feygin reference under 35 USC 102(e). Petitioner's argument for the withdrawal of the finality has merit. It is clear that the Feygin reference was improperly applied under 35 USC 102(b), in the non-final office action of July 11, 2006, and then was switched to a rejection under 35 USC 102(e) in the final office action. This change was not necessitated by amendments. Furthermore, it is clear that the new grounds of rejection of claims 11, 13-14, and 18 under 35 USC 102(e), over the Feygin reference, in the final office action, was not necessitated by amendments, since the amendments merely narrowed the scope of the small objects and liquid in the independent claims 1 and 12. Claims 11, 13-14, and 18 could have been properly rejected over the Feygin reference in the non-final office action of July 11, 2006, but were not.

Because the rejection of claims 1, 3-7, 10-16 and 18 over the Feygin reference under 35 USC 102(e), was not necessitated by amendment, the finality of the office action was premature. Accordingly, the petition for withdrawal of finality is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. Applicant's time for response continues to run from April 17, 2007. Extensions of time may be obtained to file any amendments.



Jacqueline M. Stone, Director  
Technology Center 1700  
Chemical and Materials Engineering

SONIA K. GUTERMAN  
ADAM M. SCHOEN  
LAWSON & WEITZEN, LLP  
SUITE 345  
88 BLACK FALCON AVENUE  
BOSTON, MA 02210-2414